



2132
Application No. 09/778,005
Docket No. 111325/000045

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: Mark J. Stefik et al.

Serial No. 09/778,005 ✓

Filed: 02/07/2001

For: A SYSTEM FOR CONTROLLING THE
DISTRIBUTION AND USE OF RENDERED
DIGITAL WORKS THROUGH WATERMARKING

) Examiner: Unassigned

) Group Art Unit: 2132

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INFORMATION DISCLOSURE STATEMENT

Commissioner of Patents
Washington, D.C. 20231

Sir:

In accordance with the duty of disclosure as set forth in 37 C.F.R. §1.56, Applicants hereby submit the following information in conformance with 37 C.F.R. §§ 1.97 and 1.98. Pursuant to 37 C.F.R. § 1.98, a copy of each of the documents cited is enclosed.

The documents are being submitted within three (3) months of the filing of this application or entry into the national stage of this application, or before the first Office Action on the merits, whichever is later, therefore no fee or certification is required under 37 C.F.R. § 1.97(b).

It is requested that the accompanying information disclosure statement be considered and made of record in the above-captioned application. To assist the Examiner, the documents are listed on the attached form PTO-1449. It is respectfully requested that an Examiner initialed copy of this form be returned to the undersigned.

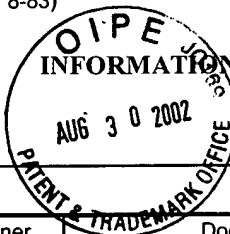
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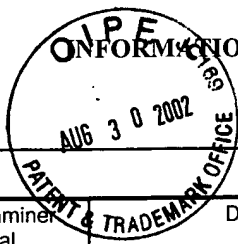
Respectfully submitted,

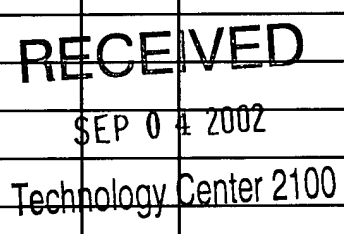
By: Marc S. Kaufman

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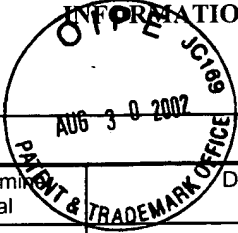
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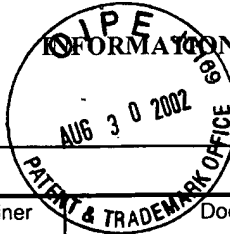
Form PTO-1449 (Rev. 8-83)		U.S. Department of Commerce Patent and Trademark Office		Atty Docket 111325-45		Serial No. 09/778,005	
 INFORMATION DISCLOSURE STATEMENT				Applicants: Stefik et al.			
				Filing Date: February 07, 2001		Group Art Unit:	
U.S. PATENT DOCUMENTS							
Examiner Initial	Document Number	Date	Name	Class	Subclass	Filing Date (if appropriate)	
	3,263,158	07/01/1966	Janis				
	3,609,697	09/28/1971	Blevins et al.				
	3,790,700	02/05/1974	Callais et al.				
	3,798,605	03/19/1974	Feistel				
	4,159,468	06/26/1979	Barnes et al.				
	4,220,991	09/02/1980	Hamano et al.				
	4,278,837	07/14/1981	Best				
	4,323,921	04/06/1982	Guillou				
	4,442,486	04/10/1984	Mayer				
	4,529,870	07/16/1985	Chaum				
	4,558,176	12/10/1985	Arnold et al.				
	4,593,376	06/03/1986	Volk				
	4,614,861	09/30/1986	Pavlov et al.				
	4,644,493	02/17/1987	Chandra et al.				
	4,658,093	04/14/1987	Hellman				
	4,817,140	03/28/1989	Chandra et al.				
	4,868,376	09/19/1989	Lessin et al.				
	4,891,838	01/02/1990	Faber				
	4,924,378	05/08/1990	Hershey et al.				
	4,932,054	06/05/1990	Chou et al.				
	4,937,863	06/26/1990	Robert et al.				
	4,949,187	08/14/1990	Cohen				
	4,953,209	08/28/1990	Ryder, Sr. et al.				
	4,961,142	10/02/1990	Elliott et al.				
	4,975,647	12/04/1990	Downer et al.				
	4,999,806	03/12/1991	Chernow et al.				
	5,010,571	04/23/1991	Katznelson				
	5,014,234	05/07/1991	Edwards, Jr.				
	5,023,907	06/11/1991	Johnson et al.				
	5,047,928	09/10/1991	Wiedemer				
	5,052,040	09/24/1991	Preston et al.				
Examiner			Date Considered				
*EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.							

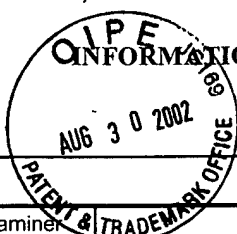
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U.S. PATENT DOCUMENTS							
Examiner Initial	Document Number	Date	Name	Class	Subclass	Filing Date (if appropriate)	
	5,058,164	10/15/1991	Elmer et al.				
	5,103,476	04/07/1992	Waite et al.				
	5,113,519	05/12/1992	Johnson et al.				
	5,136,643	08/04/1992	Fischer				
	5,138,712	08/11/1992	Corbin				
	5,146,499	09/08/1992	Geffrotin				
	5,148,481	09/15/1992	Abraham et al.				
	5,159,182	10/27/1992	Eisele				
	5,183,404	02/02/1993	Aldous et al.				
	5,191,193	03/02/1993	Le Roux				
	5,204,897	04/20/1993	Wyman				
	5,222,134	06/22/1993	Waite et al.				
	5,235,642	08/10/1993	Wobber et al.				
	5,247,575	09/21/1993	Sprague et al.				
	5,255,106	10/19/1993	Castro				
	5,260,999	11/09/1993	Wyman				
	5,263,157	11/16/1993	Janis				
	5,263,158	11/16/1993	Janis				
	5,276,444	01/04/1994	McNair				
	5,276,735	01/04/1994	Boebert et al.				
	5,291,596	03/01/1994	Mita				
	5,311,591	05/10/1994	Fischer				
	5,319,705	06/07/1994	Halter et al.				
	5,337,357	08/09/1994	Chou et al.				
	5,339,091	08/16/1994	Yamazaki et al.				
	5,341,429	08/23/1994	Stringer et al.				
	5,347,579	09/13/1994	Blandford				
	5,381,526	01/10/1995	Ellson				
	5,394,469	02/28/1995	Nagel et al.				
	5,412,717	05/02/1995	Fischer				
	5,428,606	06/27/1995	Moskowitz				
Examiner			Date Considered				



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Form PTO-1449 (Rev. 8-83)		U.S. Department of Commerce Patent and Trademark Office		Atty Docket 111325-45		Serial No. 09/778,005	
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				Filing Date: February 07, 2001		Group Art Unit:	
U.S. PATENT DOCUMENTS							
Examiner Initial	Document Number	Date	Name	Class	Subclass	Filing Date (if appropriate)	
	5,432,849	07/11/1995	Johnson et al.				
	5,438,508	08/01/1995	Wyman				
	5,444,779	08/22/1995	Daniele				
	5,453,601	09/26/1995	Rosen				
	5,455,953	10/03/1995	Russell				
	5,457,746	10/10/1995	Dolphin				
	5,473,687	12/05/1995	Lipscomb et al.				
	5,473,692	12/05/1995	Davis				
	5,499,298	03/12/1996	Narasimhalu et al.				
	5,504,814	04/02/1996	Miyahara				
	5,504,818	04/02/1996	Okano				
	5,504,837	04/02/1996	Griffeth et al.				
	5,509,070	04/16/1996	Schull				
	5,530,235	06/25/1996	Stefik et al.				
	5,532,920	07/02/1996	Hartrick et al.				
	5,534,975	07/09/1996	Stefik et al.				
	5,539,735	07/23/1996	Moskowitz				
	5,563,946	10/08/1996	Cooper et al.				
	5,568,552	10/22/1996	Davis				
	5,621,797	04/15/1997	Rosen				
	5,629,980	05/13/1997	Stefik et al.				
	5,633,932	05/27/1997	Davis et al.				
	5,634,012	05/27/1997	Stefik et al.				
	5,638,443	06/10/1997	Stefik et al.				
	5,655,077	08/05/1997	Jones et al.				
	5,708,717	01/13/1998	Alasia				
	5,734,823	03/31/1998	Saigh et al.				
	5,734,891	03/31/1998	Saigh				
	5,745,569	04/28/1998	Moskowitz et al.				
	5,748,783	05/05/1998	Rhoads				
	5,761,686	06/02/1998	Bloomberg				
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U.S. PATENT DOCUMENTS							
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	5,765,152	06/09/1998	Erickson				
	5,768,426	06/16/1998	Rhoads				
	5,825,892	10/20/1998	Braudaway et al.				
	6,047,067	04/04/2000	Rosen				
	6,115,471	09/05/2000	Oki et al.				
	6,233,684	05/15/2001	Stefik et al.				
	6,266,618	05/01/2001	Downs et al.				
	6,345,256	02/05/2002	Milsted et al.				
FOREIGN PATENT DOCUMENTS							
Examiner Initial	Document Number	Date	Country	Class	Subclass	Translation Yes No	
	0 084 441	07/27/1983	EP			Full Eng	
	0 180 460	05/07/1986	EP			Full Eng	
	0 332 707	09/01/1989	EP			Full Eng	
	0 651 554	05/03/1995	EP			Full Eng	
	0 668 695	08/23/1995	EP			Full Eng	
	0 725 376	08/07/1996	EP			Full Eng	
	2 136 175	09/12/1984	GB			Full Eng	
	2 236 604	04/10/1991	GB			Full Eng	
	WO 01/63528	08/30/2001	PCT			Full Eng	
	WO 92/20022	11/12/1992	PCT			Full Eng	
	WO 93/01550	01/21/1993	PCT			Full Eng	
	WO 99/49615	09/30/1999	PCT			Full Eng	
OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)							
Examiner Initial							
	"National Semiconductor and EPR Partner for Information Metering/Data Security Cards" March 4, 1994, Press Release from Electronic Publishing Resources, Inc.						
	Weber, R., "Digital Rights Management Technology" October 1995						
	Flasche, U. et al., "Decentralized Processing of Documents", pp. 119-131, 1986, Comput. & Graphics, Vol. 10, No. 2						
	Mori, R. et al., "Superdistribution: The Concept and the Architecture", pp. 1133-1146, 1990, The Transactions of						
Examiner				Date Considered			
*EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.							

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OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, Etc.)					
Examiner Initial					
	Weber, R., "Metering Technologies for Digital Intellectual Property", pp. 1-29, Oct. 1994, A Report to the International Federation of Reproduction Rights Organizations				
	Clark, P.C. et al., "Bits: A Smartcard protected Operating System", pp. 66-70 and 94, November 1994, Communications of the ACM, Vol. 37, No. 11				
	Ross, P.E., "Data Guard", pp. 101, June 6, 1994, Forbes				
	Saigh, W.K., "Knowledge is Sacred", 1992, Video Pocket/Page Reader Systems, Ltd.				
	Kahn, R.E., "Deposit, Registration and Recordation in an Electronic Copyright Management System", pp. 1-19, August 1992, Corporation for National Research Initiatives, Virginia				
	Hilts, P. et al., "Books While U Wait", pp. 48-50, January 3, 1994, Publishers Weekly				
	Strattner, A., "Cash Register on a Chip may Revolutionize Software Pricing and Distribution; Wave Systems Corp.", pp. 62, April 1994, Computer Shopper, Vol. 14, No. 4, ISSN 0886-0556				
	O'Conner, M., "New Distribution Option for Electronic Publishers; iOpener Data Encryption and Metering System for CD-ROM use; Column", pp. 134, March 1994, CD-ROM Professional, Vol. 7, No. 2, ISSN: 1409-0833				
	Willett, S., "Metered PCs: Is Your System Watching You? Wave System beta tests new technology", pp. 84, May 2, 1994, InfoWorld				
	Linn, R., "Copyright and Information Services in the Context of the National Research and Education Network", pp. 9-20, January 1994, IMA Intellectual Property Project Proceedings, Vol. 1, Issue 1				
	Perrit, Jr., H., "Permission Headers and Contract Law", pp. 27-48, January 1994, IMA Intellectual Property Project Proceedings, Vol. 1, Issue 1				
	Upthegrove, L., "Intellectual Property Header Descriptors: A Dynamic Approach", pp. 63-66, January 1994, IMA Intellectual Property Project Proceedings, Vol. 1, Issue 1				
	Sirbu, M., "Internet Billing Service Design and prototype Implementation", pp. 67-80, January 1994, IMA Intellectual Property Project Proceedings, Vol. 1, Issue 1				
	Simmel, S. et al., "Metering and Licensing of Resources: Kala's General Purpose Approach", pp. 81-110, January 1994, IMA Intellectual Property Project Proceedings, Vol. 1, Issue 1				
	Kahn, R., "Deposit, Registration and Recordation in an Electronic Copyright Management System", pp. 111-120, January 1994, IMA Intellectual Property Project Proceedings, Vol. 1, Issue 1				
	Tygar, J. et al., "Dyad: A System for Using Physically Secure Coprocessors", pp. 121-152, January 1994, IMA Intellectual Property Project Proceedings, Vol. 1, Issue 1				
	Griswold, G., "A Method for Protecting Copyright on Networks", pp. 169-178, January 1994, IMA Intellectual Property Project Proceedings, Vol. 1, Issue 1				
	Nelson, T., "A Publishing and Royalty Model for Networked Documents", pp. 257-259, January 1994, IMA Intellectual Property Project Proceedings, Vol. 1, Issue 1				
	Robinson, E., "Redefining Mobile Computing", pp. 238-240, 247-248 and 252, July 1993, PC Computing				
	Abadi, M. et al., "Authentication and Delegation with Smart-cards", 1990, Research Report DEC Systems Research Center				
	Mark Stefik, "Letting Loose the Light: Igniting Commerce in Electronic Publication", pp. 219-253, 1996, Internet Dreams: Archetypes, Myths, and Metaphors, IDSN 0-262-19373-6				
	Mark Stefik, "Letting Loose the Light: Igniting Commerce in Electronic Publication", pp. 2-35, February 8, 1995, Internet Dreams: Archetypes, Myths and Metaphors,				
Examiner		Date Considered			
		SEP 04 2002			
<p>*EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 709. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.</p>					

Form PTO-1449
(Rev. 8-83)

U.S. Department of Commerce
Patent and Trademark Office

Atty Docket 111325-45

Serial No. 09/778,005

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